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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/379,589	08/24/99	ROBERTS	D 1364.1001D5/
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LM12/0404

EXAMINER

VU, V

ART UNIT

PAPER NUMBER

2758

DATE MAILED:

04/04/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/379,589

Applicant(s)

Roberts et al

Examiner

V. Vu

Group Art Unit

2758

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 2/23/00
- ☒ This action is **FINAL**
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 2-82 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 2-82 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

**DETAILED ACTION**

1. This office action responds to applicant's amendment filed 2/23/2000. New claims 71-82 have been added.

**Art Rejections:**

2. The texts of 35 U.S.C. § 102(e) and 103(a) not cited here can be found in the previous office action.

3. Claims 2-5, 22, 27-28, 31-32, 35-36, 38, 41 and 81 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Doerr et al, hereafter Doerr, U.S. pat. No. 5,949,411.

Doerr discloses a method and system for collecting user input data offline at a local computer during playback of locally stored recording materials comprising the steps of:

- a) collecting user demographic data and other use data associated with the recording materials (e.g., albums/tracks/ segments, etc.,) played/viewed by the user offline (see col 2, lines 43-48),
- b) establishing a connection between the local computer and a remote server (col 6, lines 27-30),
- c) transferring the collected data from the local computer to the server via the established connection (col 6, lines 44-51),

d) transferring complimentary and update data to local computer  
(see col 7, lines 36-45).

4. Claims 7-9, 14-15, 20-21, 23-26, 29-30, 33-34, 39-40, 42 and 78-80 are rejected under 35 U.S.C. § 103 as being unpatentable over Doerr in view of Dedrick, U.S. pat. No. 5,710,884.

Doerr's teachings are still applied as discussed above. Doerr does not teach monitoring other user activity during user's session, i.e., the length, frequency, etc. Such monitoring of user's computer and user's activity for marketing purpose is well-known in the art as disclosed by Dedrick (see Dedrick's col 5, lines 17-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Doerr with Dedrick's teachings of data monitoring because it would have enabled the server to compile a more complete user profile for use by advertisers.

5. Claims 6-7, 10-13, 16-19 and 35-37 are rejected under 35 U.S.C. § 103 as being unpatentable over Doerr in view of Kaplan, U.S. pat. No. 5,963,916.

Doerr's teachings are still applied as discussed above. Doerr does not teach providing complimentary data based on use data and

user demographics. The use of use data and user demographics to select complimentary data or advertisement for providing to user is well-known in the art as disclosed in Kaplan (see Kaplan's col 16, lines 6-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize collected user data in Doerr in providing update or complimentary data to user because it would have enabled advertisers to offer products or services suitable to users' interests.

6. Claims 43-51, 54-56, 62-70 and 72-75 are rejected under 35 U.S.C. § 103 as being unpatentable over Portuesi, U.S. pat. No. 5,774,666 in view of Kaplan.

Portuesi discloses system and method for playing a recorded media content with complimentary content from a remote device comprising the steps of:

- a) playing a recording fixed in a medium owned by a user at a local device,
- b) obtaining a network identifier containing at least one embedded URL (see Portuesi's col 9, lines 22-30),

c) downloading a complimentary content, e.g., web page, from the remote device over a network using the URL (see Portuesi's col 9, lines 31-37).

Portuesi does not teach collecting use data and user demographics during the playback of the recording. However, collection of use data and user demographics from user's session for marketing purpose is well-known in the art as disclosed by Kaplan (see Kaplan's col 10, lines 62-65 and col 15, lines 54-63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Portuesi with Kaplan's collection of user demographics and use data because it would have aided advertisers in marketing their products or services to potential clients.

Kaplan further teaches providing complimentary data based upon user demographics and use data (see Kaplan's col 16, lines 6-18).

7. Claims 43, 52-53 and 57-61 are rejected under 35 U.S.C. § 103 as being unpatentable over Portuesi in view of Dedrick.

Portuesi's teachings are still applied as discussed above. Portuesi does not teach monitoring computer use activity during user's session, i.e., the length, frequency, etc. Such monitoring of computer use activity for marketing purpose is well-known in the art as disclosed by Dedrick (see Dedrick's col 5, lines 17-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Portuesi with Dedrick's teachings of data monitoring because it would have enabled the server to compile an user profile for use by the advertisers.

8. Claims 2, 22, 43, 62, 71, 76, 77, 82 are rejected under 35 U.S.C. § 103 as being unpatentable over Portuesi in view of Doerr.

Portuesi's teachings are still applied as discussed above. Portuesi does not teach collecting use data and user demographics offline during the playback of the recording. However, collection of use data from user's session for marketing purpose is well-known in the art as disclosed by Doerr (see Doerr's col 2, lines 43-48).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Portuesi with Doerr's collection of user demographics and use data because it would have aided advertisers in marketing their products or services to potential clients.

**Response to Amendment:**

9. Applicant's arguments filed on 2/23/00 with respect to claims 2-82 are moot in view of new grounds of rejection set forth above.

Applicant alleges that Kaplan fails to teach providing complimentary data based on use data and user demographic data.

This is not found persuasive. Kaplan clearly teaches providing complimentary data such as information about products or services related to the movies or albums that have been previewed by users (see Kaplan's col 16, lines 20-22).

Applicant also alleges that the applied art does not teach collecting information regarding playing of at least one portion of the recording.

This is not found persuasive. Any of the applied art above at least teaches identifying which movie or album or track has been played/previewed by the users. Since the album or track must be a portion of the recording, the alleged limitation is wholly met by prior art teachings.

**Conclusion:**

10. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED



Serial No. 09/379,589

UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Friday from 7:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



**VIET D. VU**  
**PRIMARY EXAMINER**

Art Unit 2758  
3/30/00